

ATTORNEY DOCKET NO.
35-95-010.1
(014208.1386)

PATENT APPLICATION

09/05/00 1647

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REMARKS

Claims 7-8 and 24-26 are pending in the application. In view of the remarks which follow, reconsideration is respectfully requested.

Change of Correspondence Address

Applicants are submitting concurrently with this Response a Change of Correspondence Address. The Examiner is requested to verify that the new correspondence address has been properly entered into the PTO file for this application, and also into the PTO computer system.

Claim 7 is Not Anticipated Under §102 by Reilly

Turning to the merits, the Examiner has maintained the rejection of independent Claim 7 for anticipation under 35 U.S.C. §102, based on Reilly U.S. Patent No. 5,740,549. Applicants have previously emphasized that Claim 7 includes a limitation involving a time interval, in particular "presenting the advertising item to the user of the electronic publication after passage of a predetermined amount of time during which the electronic publication has been in use." In paragraph 6 of the Office Action, which begins in the middle of page 5, the Examiner notes that a time interval of 30 seconds is disclosed in the portion of Reilly at lines 25-46 of column 5. This is true, but this time interval of Reilly is radically different from the time interval recited by Applicants, as discussed below.

Applicants first note that, with respect to the limitation of interest from Claim 7, the §102 rejection does not rely on this portion of Reilly, but instead on the portion of Reilly at lines 40-52 of column 11. Consequently, the

comments in paragraph 6 on page 5 appear to contemplate a new and different ground of rejection under §102 based on Reilly, which is not formally presented in the Office Action, and which could not be properly presented for the first time in a final rejection such as the present Office Action. In any event, the 30-second time interval discussed in column 5 of Reilly is completely different from the time interval recited in Claim 7.

In particular, the time interval recited in Claim 7 runs from (1) the point in time when the user begins using the electronic publication to (2) the point in time where the recited advertising item is presented to the user. In contrast, the 30-second time interval in column 5 of Reilly runs from (1) the point in time when the advertising item is presented to the user to (2) a point in time 30 seconds later when that advertising item is replaced with a different advertising item. The 30-second time interval of Reilly thus does not start at the time the user begins using the electronic publication, nor does it end when the advertising item is first presented to the user. The time interval of Reilly is thus entirely different from the time interval recited in Claim 7. Accordingly, it is respectfully submitted that Reilly fails to teach an element of the combination recited in Claim 7, and thus fails to anticipate Claim 7 under 35 U.S.C. §102. It is therefore respectfully requested that the §102 rejection of Claim 7 be withdrawn, and that Claim 7 be allowed.

Claim 8 is Not Anticipated Under §102 by Reilly

Turning to independent Claim 8, the Examiner maintained the prior rejection of Claim 8 under §102 based on Reilly. Applicants have previously emphasized the fact that

Claim 8 recites "presenting the advertising item to the user of the electronic publication in response to the access of a specific content item". In the paragraph which bridges pages 5-6 of the Office Action, the Examiner asserts that Reilly discloses this precise feature. Applicants respectfully disagree. The indicated portion of Reilly does not appear to teach or suggest any one-to-one relationship between a specific content item and a specific advertisement, much less the idea of presenting the particular advertising item to the user in direct response to the user's request to view the corresponding content item. It is thus respectfully submitted that the combination recited in Claim 8 includes an element which is clearly not disclosed in Reilly. It is therefore respectfully submitted that Claim 8 is not anticipated under §102 by Reilly. Accordingly, it is respectfully requested that the §102 rejection of Claim 8 be withdrawn, and that Claim 8 be allowed.

Other Claims

Claims 24-25 and Claim 26 respectively depend from Claim 7 and Claim 8, and are also believed to be allowable over the art of record, for example for the same reasons discussed above with respect to Claims 7 and 8.

Conclusion

Based on the foregoing, it respectfully submitted that all of the pending claims are fully allowable, and favorable reconsideration of this application is therefore respectfully requested. If the Examiner believes that examination of the present application may be advanced in any way by a telephone conference, the Examiner is invited to telephone the undersigned attorney at (214) 953-6684.

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Although Applicants believe that no additional fees are due, the Commissioner is hereby authorized to charge any fee required by this paper, or to credit any overpayment, to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,
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Date: February 27, 2001

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